

Applicant: Battaglia
Serial No. 10/053,313
Filing Date: January 18, 2002

PATENT
Attorney Docket No.: JAL1100-1
(formerly ALBA.001.01US)

REMARKS

Claims 1-14, 26 and 27 are pending and under consideration. Claim 26 has been amended to correct the prior dependency on a non-elected claim. New claims 29-32 have been added. No new matter has been added and the claims find support, for example, on page 10, lines 1-20 and page 11, lines 8-29. In view of the remarks herein, Applicants respectfully request reconsideration of the pending claims.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-13 and 26 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over Mantelle (5,446,070). Applicant respectfully traverses this rejection.

Amongst the various comments made in the Office Action, Applicant notes in particular on page 3 that it is asserted that Mantelle describes the use of gum resin guar gum as the adhesive carrier. Further, the Office Action states that "the solvent of claim 1 can be the glycols of column 6, line 63 to column 67, line 38".

First, Applicant notes that on page 12, line 64, Mantelle lists "guar gum" and not a gum resin as alleged by the Office Action. The gums described by Mantelle, including guar gum, karaya gum and tragacanth gum, are all water soluble gums (see col. 13, lines 39-45 for example). A gum is a dry exudate from a plant that is *water* soluble. In contrast, a resin is a dry exudate from a plant that is soluble in *alcohol* but not water. A gum resin has properties of both, namely it is partially soluble in water and alcohol.

Mantelle only describes water soluble gums. Water soluble gums were specifically used by Mantelle (see for example, Examples 1-36 of Mantelle) in order to form a gelatinous, wet, emulsion for administration to the skin surface. This emulsion composition "is not dried to prevent removal of the solvent from the adhesive or a solvent is used at least part of which is not substantially evaporated during the conditions of manufacture. The composition in question can then be applied to a flexible backing..." (col 11, lines 59-67).

In contrast, Applicant claims a "gum resin", e.g., benzoin, which is a vehicle not purely water soluble nor purely alcohol soluble, but soluble in a combination of alcohol plus water.

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Applicant's composition contains substances that specifically allow it to become a *dry* medicated film on the skin surface. In contrast, the composition described by Mantelle remains a wet, gelatinous mixture on the skin and in order to keep the material on the skin, a backing must be applied. Applicant has designed a composition that remains dry on the skin until it is removed with a volatile solvent, e.g., ethanol. One of skill in the art would not have used the teaching in Mantelle to prepare a composition that remained dry on the skin of the subject to whom it was administered.


Mantelle describes the use of a solvent containing adhesive, yet the reference notes that the solvent is a "non-volatile solvent". (col. 11, lines 59-65). Thus, Mantelle actually teaches away from Applicant's use of a volatile solvent in the claimed composition.

Thus, there would be no motivation to take the teachings of Mantelle which provides a wet, gelatinous, gum based product, to arrive at Applicant's claimed composition containing a gum resin and a volatile solvent. Accordingly, Applicant requests removal of the rejection under §103.

In view of the above remarks, it is submitted that the claims are in condition for allowance and a notice to that effect is respectfully requested. The Examiner is invited to contact Applicant's undersigned representative if there are any questions relating to this application. Please charge any additional fees, or make any credits, to Deposit Account No. 50-1355.

Respectfully submitted,

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